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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/843,771 | 04/30/2001 | Gideon Fostick | Q63730 | 1088 |

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| | |
|------------|--------------|
| EXAMINER | |
| CHOW, MING | |
| ART UNIT | PAPER NUMBER |
| 2645 | 10 |

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,771

Applicant(s)

FOSTICK, GIDEON

Examiner

Ming Chow

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-9, 11-15 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-9, 11-15 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. The reply filed on 4-23-04 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): The replacement of drawing was not received. Applicant must re-submit the replacement of drawing with next response to the Office Action.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the Interactive Voice Response System claimed in claims 6, 7 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claim 14 recites the limitation "said textual format message". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "said message" (line 5) is not clearly defined. It is unclear the term refers to "SMS message" (line 2) or "a voice message" (line 4).

Also, the term "said message" (line 6) is not clearly defined. It is unclear the term refers to "SMS message" (line 2) or "a voice message" (line 4).

Also, the term "the text message" (line 10) is not clearly defined. It is unclear the term refers to "text" (line 6) or "a text message" (line 10).

Also, the term "said text" (line 11) is unclear it refers to "text" (line 6) or "a text message" (line 10).

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Claim 7 claims "said text message" (line 12) is unclear it refers to "text message portion" (line 7-8) or "a text message" (line 10).

Claim 24 claims "the text message" and "the text message portion" (line 4) is unclear it refers to "the text message" of claim 22 line 6 or "a text message portion" of claim 24 line 2-3.

6. Claims 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "said text message" (line 6) is not clearly defined. The claimed "said text message" on line 6 refers to "a text message" on line 3. The "a text message" on line 3 is from a voice message. However, the "said text message" on line 6 includes a pre-prepared message that is not from "a voice message" of line 3.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make

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and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 7, 9, 12, 24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “converting said voice message to text message portion” is not disclosed by the specification. The specification did not support the conversion of a voice message into only a portion of text of the full message.

8. Claims 15, 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “converting the voice message sent to said CAS to a non-voice format” is not disclosed by the specification. The “non-voice format” includes the video format that is not supported by the specifications.

9. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “said voice message is converted before having entered a voice mail box” is not disclosed by the specification. First, to anyone skilled in the art, a voicemail box contains only

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voicemails but NOT text mails. Also, the specification, on section [0076], disclosed that voicemail box is for receiving voice messages.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6, 9, 11, 12, 13, 14, 15, 22, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agraharam et al (US: 6483899), and in view of Parson et al (US: 2002/0085701).

Agraharam et al teach on item 100 Fig. 1, a voice-enabled communications device.

Agraharam et al teach on column 1 line 52-60 a voice-messaging system converts voice message into a text message by using the speech recognition software.

Agraharam et al failed to teach “an interactive voice response system”. However, Parson et al teach on section [0090], an IVR allows a caller to select canned messages and further append with caller’s phone number.

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Agraharam et al teach on column 1 line 58-64, the CAS sends the text message to the recipient.

Agraharam et al teach on column 3 line 5-8, the calling party is prompted to provide information. Agraharam et al failed to teach the “prompt” is via an interactive voice response system. By combining the IVR as taught by Parson et al, the calling party selected message and the appended message are the claimed “text message”.

Agraharam et al failed to teach “the pre-prepared messages are pre-programmed by a called party”. However, the person who pre-program the message is a “decide choice”.

It would have been obvious to one skilled at the time the invention was made to modify Agraharam et al to have an IVR as taught by Parson et al such that the modified system of Agraharam et al would be able to support the system users with a flexible means to select a pre-programmed message. Further, it would have been obvious to one skilled at the time the invention was made to modify Agraharam et al to have a called party pre-program messages.

11. Claims 6, 7, 8, 9, 11, 12, 13, 14, 15, 22, 23, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davidson et al (US: 6775360), and in view of Bannister et al (US: 5943399).

Davidson et al teach on item 140 Fig. 1, caller places a voice message on a telephone.

Davidson et al teach on column 3 line 13-26, voice mail server (claimed “CAS”).

Davidson et al teach on item 320 Fig. 3, speech recognition server converting voice messages into text and transferring converted text to the voice mail server.

Davidson et al failed to teach “an interactive voice response system”. However, Bannister et al teach on column 1 line 23-30, callers select predefined SMS (text messages) via an IVR.

Davidson et al teach on column 4 line 3-10, the voicemail server (claimed “CAS”) provides a text message includes the converted text and other indicia of the message (the “SMS” of Bannister et al; claimed “pre-prepared message”).

Davidson et al failed to teach “pre-pared messages are pre-programmed by a called party”. However, the person who pre-program the message is a “decide choice”.

It would have been obvious to one skilled at the time the invention was made to modify Davidson et al to have an IVR as taught by Bannister et al such that the modified system of Davidson et al would be able to support the system users with a flexible means to select a pre-programmed message. Further, it would have been obvious to one skilled at the time the invention was made to modify Davidson et al to have a called party pre-program messages.

Conclusion

12. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Brown et al (US: 5333180) teach call message delivery system.

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13. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

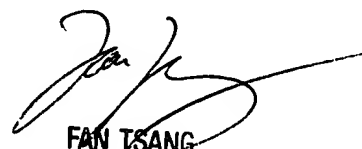
Washington, D.C. 20231

Or faxed to Central FAX Number 703-872-9306.

Patent Examiner

Art Unit 2645

Ming Chow



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600